## II. Remarks

### A. Introduction

Reconsideration and allowance of the present application are respectfully requested.

Claims 1-23 and 25-31 are pending in the present application. Claims 1, 25 and 30 are independent. Claims 1, 4, 7, 8, 16, 17, 19-21, 25, and 27-30 have been amended. Claim 24 has been cancelled. Claim 31 has been added. No new matter has been introduced.

Support for the amendments to Claims 1, 25, and 30 are found in paragraphs 25 and 48 of the specification, as well as elsewhere throughout the originally filed specification, claims and drawings. Support for new Claim 31 is found in paragraphs 28-29 of the specification, as well as elsewhere throughout the originally filed specification, claims and drawings.

### B. Drawings Accepted

Applicant acknowledges, with appreciation, that the drawings filed on March 23, 2006, are accepted.

### C. Claim Rejections under 35 U.S.C. § 112, second paragraph

Claim 4 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite because Applicant uses "the phrase 'greater than or equal to' in the claims when describing UV protection factor," and it "is unclear to the examiner if it is 'greater than' or 'equal to' are the intended values." (*See* Office Action, page 2). The standard for evaluating indefiniteness is an objective standard of whether the claim scope is clear to a hypothetical person possessing the ordinary level of skill in the art. (*See* MPEP § 2171). The Office Action has set forth no evidence that a person possessing the ordinary level of skill in the art would view the claims to be indefinite. (*Cf. Exxon Research & Engineering Co. v. United States*, 46 Fed. Cl. 278, 295-96 (U.S. Ct. Fed. Cl. 2000) *rev'd* 265 F.3d 1371 (Fed. Cir. 2001) (finding that the term "a Peclet number of ***greater than or equal*** to 0.2" to be definite) (emphasis added)). However to expedite prosecution, Applicant has amended dependent Claim 4 and added new dependent Claim 31 to clearly indicate the scope of Applicant's invention. Therefore, this rejection of dependent Claim 4 is rendered moot.

**D. Claim Rejections under 35 U.S.C. § 102(b)**

Independent Claims 1, 25, and 30, as well as dependent Claims 2-5, 18-20, 23, and 24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,352,457 to Jenkins, et al. ("Jenkins"). Independent Claims 1, 25, and 30, as well as dependent Claims 2-5, 18-20, 23, and 24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,906,830 to Farinas, et al. ("Farinas"). Independent Claims 1, 25, and 30, as well as dependent Claims 2-5, 16-21, 23, 24 and 26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,692,462 to Banerjee, et al. ("Banerjee"). Applicant traverses these rejections in view of the amended claims and the arguments set forth below.

**1. Jenkins Fails to Teach Every Claim Element under 35 U.S.C. § 102(b)**

To reject a claim based on 35 U.S.C. § 102(b) all of the claim limitations must be taught by a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.").

Independent Claim 1, as amended, recites "wherein at least one of the first and second layers is ***opaque*** to UV radiation, and further wherein the ***patch is substantially transparent to visible light***." (Emphasis added). Independent Claims 25 and 30 recite similar features. The specification defines "opaque" as being "substantially impenetrable by a form of radiation other than visible light." (*See* Application, para. 25). The Office Action has cited Jenkins for teaching "a transdermal device comprising a backing adjacent to an adhesive layer." (*See* Office Action, page 3). The backing in Jenkins is a metal polyester laminate. (*See* Jenkins, Col. 5, lines 32-36). Further, the Office Action admits that even though Jenkins does not teach that "one of the layers being opaque to UV radiation it [is] the position of the examiner that this limitation is met. It is widely known that metals reflect visible light as well as UV radiation. Therefore, because the backing layer comprise metal the limitation is inherent." (*See* Office Action, page 3). The Examiner has admitted that such metals used in Jenkins are widely known to ***reflect visible light***. None of the backing materials disclosed in Jenkins permits the production of a patch that is substantially transparent to visible light and which also comprises a layer that is opaque to UV

radiation such that the patch is for reducing UV radiation exposure as claimed in Claims 1, 25, and 30. Jenkins cannot teach a patch that is substantially transparent to visible light as claimed. Further, the allegations that metals are opaque because they reflect visible light that includes UV radiation is not encompassed within the definition of opaque provided by Applicant which states that opaque means "substantially impenetrable by a form of radiation other than visible light." Therefore, for at least these reasons, Jenkins fails to teach every element of independent Claims 1, 25, and 30 and, accordingly Claims 1, 25, and 30 are patentable over Jenkins.

**2. Farinas Fails to Teach Every Claim Element under 35 U.S.C. § 102(b)**

Independent Claim 1, as amended, recites "wherein at least one of the first and second layers is ***opaque*** to UV radiation, and further wherein the ***patch is substantially transparent to visible light***." (Emphasis added). Independent Claims 25 and 30 recite similar features. The Office Action has cited Farinas for teaching "a transdermal device comprising a backing adjacent to an adhesive layer." (*See* Office Action, page 4). The backing in Farinas can be metallized. (*See* Farinas, Col. 8, line 59 to Col. 9, line 15). Further, the Office Action admits that even though Farinas does not teach that "one of the layers being opaque to UV radiation it [is] the position of the examiner that this limitation is met. It is widely known that metals reflect visible light as well as UV radiation. Therefore, because the backing layer comprise metal the limitation is inherent." (*See* Office Action, page 4). The Examiner has admitted that such metals used in Farinas are widely known to ***reflect visible light***. There is no teaching or suggestion in Farinas to provide a patch which is made of a material that is suitable both to be opaque to UV radiation while at the same time substantially transparent to visible light. The materials described as being suitable as backing layer are either transparent to visible and UV light (e.g. unmodified polyesters, polyethylene etc) or opaque to both visible and UV radiation (e.g. metallized layers). Farinas cannot teach a patch that is substantially transparent to visible light as claimed. Further, the allegations that metals are opaque because they reflect visible light that includes UV radiation is not encompassed within the definition of opaque provided by Applicant which states that opaque means "substantially impenetrable by a form of radiation other than visible light." Therefore, for at least these reasons, Farinas fails to teach every element of independent Claims 1, 25, and 30 and, accordingly Claims 1, 25, and 30 are patentable over Farinas.

**3. Banerjee Fails to Teach Every Claim Element under 35 U.S.C. § 102(b)**

Independent Claim 1, as amended, recites "wherein at least one of the first and second layers is ***opaque*** to UV radiation, and further wherein the ***patch is substantially transparent to visible light***." (Emphasis added). Independent Claims 25 and 30 recite similar features. The Office Action has cited Banerjee for teaching "a transdermal device comprising a backing adjacent to an adhesive layer." (See Office Action, page 3). The backing in Banerjee is aluminum foil. (*See* Banerjee, Col. 3, lines 39-44). Further, the Office Action admits that even though Banerjee does not teach that "one of the layers being opaque to UV radiation it [is] the position of the examiner that this limitation is met. It is widely known that metals reflect visible light as well as UV radiation. Therefore, because the backing layer comprise metal the limitation is inherent." (*See* Office Action, page 5). The Examiner has admitted that such metals used in Banerjee are widely known to ***reflect visible light***. None of the backing materials disclosed in Banerjee can result in a patch in which at least one layer is opaque to UV radiation whilst the patch is substantially transparent to visible light. Banerjee cannot teach a patch that is substantially transparent to visible light as claimed. Further, the allegations that metals are opaque because they reflect visible light that includes UV radiation is not encompassed within the definition of opaque provided by Applicant which states that opaque means "substantially impenetrable by a form of radiation other than visible light." Therefore, for at least these reasons, Banerjee fails to teach every element of independent Claims 1, 25, and 30 and Claims 1, 25, and 30 are patentable over Banerjee.

**4. Dependent Claims**

As indicated above, dependent Claims 2-5, 18-20, 23, and 24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Jenkins or Farinas. Also, dependent Claims 2-5, 16-21, 23, 24 and 26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Banerjee. Dependent Claims 6-15, 22, and 27-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jenkins or Farinas or Banerjee in view of U.S. Patent No. 6,037,280 to Edwards et al. and WO02/059407 to Woods. Dependent Claims 2-23 and 31 contain all the limitations of independent Claim 1 from which they depend and thus are patentable over the cited references for at least the same reasons as independent Claim 1. Dependent Claims 26-29

contain all the limitations of independent Claim 25 from which they depend and thus are patentable over the cited references for at least the same reasons as independent Claim 25.

**5. Multiplying References**

Three references, Jenkins, Farinas and Banerjee, have been used to reject the claims in a similar manner in the Office Action, and each rejection repeats the same grounds of rejection using almost identical language. This multiplication of the references should be avoided as directed by Section 904.03 of the MPEP, which states:

> In selecting the references to be cited, the examiner should carefully compare the references with one another and with the applicant's disclosure to avoid the citation of an unnecessary number. The examiner is not called upon to cite all references that may be available, but only the "best." (37 CFR 1.104(c).) Multiplying references, any one of which is as good as, but no better than, the others, adds to the burden and cost of prosecution and should therefore be avoided. The examiner must fully consider all the prior art references cited in the application, including those cited by the applicant in a properly submitted Information Disclosure Statement.

Applicant respectively requests that the Examiner to cite the best references available to avoid the unnecessary and burdensome practice of multiplying the references.

**E. Conclusion**

In view of the above remarks, it is believed that this application is in condition for allowance, and a Notice thereof is respectfully requested.

Applicant's undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 625-3536. All correspondence should continue to be directed to the below-listed address.

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